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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,848	05/31/2000	Beatrice Gaugler	LUD 5353.7 DIV (10016357)	4358
24972	7590	09/10/2004	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			DAVIS, MINH TAM B	
			ART UNIT	PAPER NUMBER

1642

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,848

Applicant(s)

GAUGLER ET AL.

Examiner

MINH-TAM DAVIS

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1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 75-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 75-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Accordingly, claims 75-80 are being examined.

The following are the remaining rejections.

REJECTION UNDER 35 USC 112, FIRST PARAGRAPH, SCOPE

Claims 75-80 are rejected under 35 USC 112, first paragraph, because the specification, while being enabling for an isolated cDNA molecule encoding a peptide consisting of the amino acid sequence encoded by the nucleotides 70-96 of the polynucleotide sequence of SEQ ID NO:18, is not enabled for an isolated cDNA molecule encoding "a polypeptide".

Applicant argues that the claims are now amended to recite what the Examiner has stated is allowable. Applicant asserts that that Applicant's representative was advised that the 27 nucleotides had to encode the peptide shown to be expressed as a TRA, i.e. defined by nucleotides 70-96 of SEQ ID NO:18.

Rejection remains, because the amended claims do not incorporate the limitation that the claimed cDNA molecule had to encode the peptide shown to be expressed as a TRA, i.e. defined by nucleotides 70-96 of SEQ ID NO:18

The amended claims 75-80 are drawn to:

An isolated cDNA molecule, which encodes "a polypeptide", consisting of at least nucleotides 70-96 of SEQ ID NO:18 and no more than the complete nucleotide

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sequence of SEQ ID NO:18, an expression vector and a host cell comprising said cDNA molecule.

The amended claims now encompass an isolated cDNA molecule, which encodes any polypeptide of any structure and any length, wherein said cDNA molecule consists of at least nucleotides 70-96 of SEQ ID NO:18 and no more than the complete nucleotide sequence of SEQ ID NO:18, an expression vector and a host cell comprising said cDNA molecule.

The specification discloses a polynucleotide fragment consisting of SEQ ID NO:18 of 225 nucleotides in length (p.9, line 16 and Example 32 on page 35-35). The specification incorporates by reference application 938/334, now patented US 5,404,940 which teaches the nonapeptide of SEQ ID NO:9, which is encoded by nucleotides 70-96 of SEQ ID NO:18 of the instantly claimed invention.

One cannot extrapolate the teaching in the specification to the claims. Applicant has not taught how to make the claimed numerous encoded polypeptides, such that they would have the property or function as claimed. Applicant has not taught how to use the claimed numerous encoded polypeptides. For example, Applicant has not taught what the structure and/or function is for the claimed encoded polypeptides, which do not even necessarily have the nonapeptide of SEQ ID NO:9, in view of three possible reading frames of SEQ ID NO:18 and in view that SEQ ID NO:18 is only a cDNA fragment of 225 nucleotides in length. Thus, in view of the unpredictability of protein chemistry, as taught by Bowie et al, Burgess et al, Lazar et al, Tao et al and

Gillies et al, all of record, it would be an undue experimentation for one of skill in the art to practice the claimed invention.

The claim 75 can be clarified, and the rejection can be obviated by amending claim 75, for example, to recite "An isolated cDNA molecule consisting of at least nucleotides 70-96 of SEQ ID NO:18 and no more than the complete nucleotide sequence of SEQ ID NO:18, wherein said cDNA molecule encodes a peptide consisting of the amino acid sequence encoded by the nucleotides 70-96 of the nucleotide sequence of SEQ ID NO:18."

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

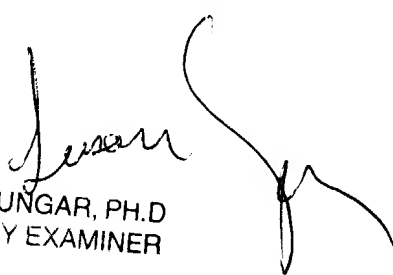
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 571-272-0830. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY SIEW can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MINH TAM DAVIS
August 25, 2004


SUSAN UNGAR, PH.D
PRIMARY EXAMINER